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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,663	11/27/2001	Toshiaki Sasaki	862.C2452	8052
5514	7590	07/05/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			GLASS, RUSSELL S	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			3626	

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/993,663	<b>Applicant(s)</b> SASAKI ET AL.	
	<b>Examiner</b> Russell S. Glass	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-99 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 15-99 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/12/02, etc.</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 15-99 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 5, 2006.

Applicant's election with traverse of claims 1-14 in the reply filed on June 5, 2006 is acknowledged. The traversal is on the ground(s) that undue burden has not been shown by the examiner. This is not found persuasive because the restriction requirement stated that inventions II, IV-VI are all classified separately. This shows undue burden because each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification. Furthermore, the restriction requirement stated that inventions I and III, although both classified in 705/3, would require a different field of search, because of the medical facility or drugstore terminal limitation of invention III. This also establishes a showing of undue burden on the examiner. Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes /subclasses or electronic resources, **or employing different search queries**), a different field of search is shown, even though the two are classified together. The

Art Unit: 3626

indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

**The requirement is still deemed proper and is therefore made FINAL.**

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-4, 6-11, 13, 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Bayne, (U.S. 2005/0060198).**

4. As per claim 8, Bayne discloses a health management method of managing health of each user carrying a portable terminal, including the steps of:

providing a portable terminal carried by a user with a display screen, radio communication means for accessing a predetermined radio communication network, storage means storing personal information of the user, and an input/output device for supporting health management for the user, (Bayne, Abstract; ¶ 36, 39-41);

providing a database for communicating with each portable terminal with personal information storage means storing the personal information about each user carrying the portable terminal, medical information storage means storing information about a medical facility, a drugstore, a medicine, and the input/output device, and communication means for communicating with the portable terminal through the radio communication network, (Bayne, Abstract; ¶¶ 36, 45-47, 96);

transmitting part of the personal information stored in the storage means by the radio communication means when starting to communicate with the database, (Bayne, Abstract; ¶¶ 36, 45);

identifying in the database, the user of the portable terminal by collating the part of the information transmitted from the radio communication means with information stored in the personal information storage means, (Bayne, Abstract; ¶¶ 36, 45); and

providing one of communication with a medical facility whose information is stored in the medical information storage means and information stored in the medicine information storage means, which is necessary for the identified user for the portable terminal when a specific signal is transmitted from the radio communication means, (Bayne, ¶¶ 50).

5. As per claim 9, Bayne discloses a method wherein the personal information includes information of a clinical chart of the user and prescription, (Bayne ¶¶ 93).

6. As per claim 10, Bayne discloses a method wherein the radio communication

Art Unit: 3626

means and the communication means perform encryption/decryption in accordance with a predetermined scheme in transmitting/receiving at least part of the personal information, (Bayne, ¶ 45).

7. As per claim 11, Bayne discloses a method wherein the portable terminal acquires position information of the terminal, and information about a route to a suitable medical facility or drugstore is displayed on the display screen on the basis of the position information, (Bayne, ¶ 39, 40, 50).

8. As per claim 13, Bayne discloses a method wherein in the database, when no information is transmitted a predetermined period of time after a specific signal is transmitted from the radio communication means, communication is made to an emergency facility, (Bayne, ¶ 77-84) (disclosing automatic emergency call initiation).

9. As per claim 14, Bayne discloses a method wherein part of the information includes information about biometrical characteristics of the user, (Bayne ¶ 93).

10. As per claims 1-4, 6, 7 these system claims contain the same or similar limitations as the corresponding method claims 8-11, 13, 14, respectively, and claims 1-4, 6, 7 are therefore rejected by incorporating the rejections of claims 8-11, 13, 14 herein by reference.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**11. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayne, (U.S. 2005/0060198), in view of Mishelevich et al., (U.S. 5,363,842).**

12. As per claim 12, Bayne fails to disclose a method wherein the input/output device is an inhaler for discharging a medicine in the form of fine droplets to make the user inhale the droplets, and the information about the input/output device includes information about handling of the inhaler. However, such a method is well known in the art as evidenced by Mishelevich, (Mishelevich, Abstract, col. 4, line 35 - col. 5, line 18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne and Mishelevich. The motivation would have been to create a hand-held inhaler device to provide information to both patient and healthcare professional regarding correct usage, actuation, flow rate, and duration, (Mishelevich, col. 4, lines 16-32).

Art Unit: 3626

13. As per claim 5, the system claims contain the same or similar limitations as the corresponding method claims 12. Claim 5 is therefore rejected by incorporating the rejection of claim 12 herein by reference.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows: Otworth et al., (U.S. 2002/0059030); Kehr et al., (U.S. 2003/0036683); DeLaHueraga, (U.S. 6,408,330); Chan et al., (U.S. 2001/0039503); Wallace et al., (U.S. 6,564,121); Weinberger, (U.S. 5,408,443).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Application/Control Number: 09/993,663

Page 8

Art Unit: 3626

Customer Service Representative or access to the automated information system, call  
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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6/21/2006

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C. LUKE GILLIGAN  
PATENT EXAMINER